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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,404	08/28/2006	Paul McBride		5198

7590 03/04/2008  
John Wiley Horton  
Pennington, Moore, Wilkinson, Bell & Dunbar  
215 S. Monroe St.  
Tallahassee, FL 32301

EXAMINER
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MORAN, KATHERINE M

ART UNIT	PAPER NUMBER
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3765

MAIL DATE	DELIVERY MODE
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03/04/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/578,404

**Applicant(s)**

MCBRIDE, PAUL

**Examiner**

Katherine Moran

**Art Unit**

3765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

### **DETAILED ACTION**

Applicant's amendment of 12/3/07 has been received. The response amended claims 1 and 8 and added new claims 10-12. Claims 1-12 are pending.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 12 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 12 recites a lens region of a third hardness grade which is harder than the first and second hardness grades associated with the visor region and eye sealing elements.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 5, 6, and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Harrison (U.S. 2004/0218286). Harrison discloses the invention as claimed. Harrison discloses swimming goggles 10 comprising a face-covering element which comprises a visor region formed by a first layer 14A of transparent silicone material having a first hardness grade and made of a first material, two eye sealing elements 14B formed integrally with the first layer, the sealing elements made of a second material having a second hardness grade which is softer than the first grade, and two lens regions 12 formed integrally with the first layer. The lens region is made of a third material having a hardness grade harder than the first and second hardness grades (see col.3, lines 11-13 and lines 23-33) and includes molded nose region 20. Band 22 encircles the wearer's head.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drew (U.S. 4,279,039). Drew discloses the invention substantially as claimed. Drew discloses the invention substantially as claimed. Drew teaches swimming goggles comprising a unitary face-covering element comprising a visor region formed by a first layer of transparent elastic material 16, eye sealing elements 48 adapted to sealingly

engage with a wearer's face, and fastening means 18 which hold the goggles in place.

The first layer is elastically deformable with the eye sealing elements to engage the wearer's face since the first layer is formed from polystyrene. A molded nose region (shown but not labeled) is provided to fit around the wearer's nose. The visor region may comprise a single lens region as disclosed in col. 3, lines 8-11 or two lens regions 24. The fastening means comprises a band 18 which encircles the wearer's head.

However, Drew doesn't teach the first layer co-molded with the eye sealing elements in a unitary construction. This is a product by process limitation and as such, is limited by and defined by the process, though determination of patentability is based on the product itself. The structure implied by the process steps should be considered when assessing the patentability of product by process claims over the prior art. Drew teaches that the first layer 16 may be fabricated as a unitary component. Drew's eye sealing elements 48 and first layer 16 are formed from polymeric materials which are commonly molded to form the desired end product in a unitary construction. Therefore, it would have been obvious to form Drew's first layer and eye sealing elements as a unitary component to prevent poor sealing between the respective structural elements.

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Drew in view of Douglas (U.S. 3,755,819). Drew discloses the invention substantially as claimed. However, Drew doesn't teach fastening means comprising arms which are releasably fastened together. Douglas teaches arms 24 (col.9, lines 50-54) which may be releasably fastened together via hook or buckle means. Therefore, it would have

been obvious to substitute Drew's fastening means with that of Douglas to allow for the goggles to fit a variety of head sizes.

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Drew in view of Hewitt et al. (Hewitt, U.S. 5,216,759). Drew discloses the invention substantially as claimed. However, Drew doesn't teach the visor region is treated with an anti-fog coating. Hewitt teaches the lens region is treated with an anti-fog coating. Therefore, it would have been obvious to provide Drew's visor region, which includes the lenses, with the anti-fog coating as taught by Hewitt in order to reduce the possibility of foggy lenses.

### ***Response to Arguments***

9. Applicant's remarks are directed to the amended claim limitations. These amended claim limitations are addressed above.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications should be directed to Primary Examiner Katherine Moran at (571) 272-4990. The examiner can be reached on Monday-Thursday from 8:30 am to 6:00 pm, and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Welch, may be reached at (571) 272-4996. The official and after final fax number for the organization where this application is assigned is (571) 273-8300. General information regarding this application may be obtained by contacting the Group Receptionist at (571) 272-3700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kmm

February 22, 2008

Art Unit: 3765

/Katherine Moran/

Primary Examiner, Art Unit 3765